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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,613	01/15/2004	Ruopak Nanyamka Omar		6346

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MR. RUUPAK OMAR
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EXAMINER

HYLINSKI, ALYSSA MARIE

ART UNIT	PAPER NUMBER
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3711

MAIL DATE	DELIVERY MODE
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04/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,613

Applicant(s)

OMAR, RUUPAK NANYAMKA

Examiner

Alyssa M. Hylnski

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 and 33-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 and 33-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification discloses a volume of the head prior to combining with the ball (V_H) which is unclear since the device is formed by the face being combined with the ball to form the head portion making what part or parts are supposed to make up the head portion difficult to determine.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 22-27, 33-37 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 discloses a volume of the head prior to the combination of the face with the ball (V_H) but section 'b' of the claim discloses the face combined with the ball forming the athlete's head, making it unclear as to what is meant and required by the limitation of the head portion with respect to the volume calculation. The claim also recites that the formula results in the

combined ball and face being generally the size of the head of the athlete, which is also unclear since the formula is based off an arbitrary ball volume so if a volume for the ball is used that would be smaller than a head of the athlete the formula would not result in the face and ball combination being about the size of an athlete's head. Claims 23-27 and 33-37 are rejected for being dependent on a rejected base claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash (6517406), Burton (D394479), Kimbrough (5926388), Wolf (6655056) and Lerner (3660926). Cash discloses a sports novelty article having a three-dimensional representation of a baseball with a face (48) positioned on the ball such that the ball continues from the face to form the remainder of the head (Fig. 1). The relative size of the representation of the ball and the representation of the face is such that the ball is generally the size of the representation of the head (Fig. 1). The three-dimensional representation of the ball is proportional to the represented ball (Fig. 1). The novelty article is a figurine with arms and legs (14,16) wherein the combination of the three-dimensional representation of the ball and the face is selectively attachable to the figurine (Fig. 2). Burton discloses a ball shaped doll having three-dimensional facial features and a ball that is generally the size of the represented head (Fig. 2) such that

the representation of the face protrudes outwardly from the three-dimensional representation of the ball, showing this quality to be old in the ball figurine art. It would have been obvious to one of ordinary skill in the art to have the face of Cash display three-dimensional characteristics in order to have a doll with more interesting and visually appealing features. Cash and Burton disclose the basic inventive concept of a sports novelty article with the exception of the three-dimensional representation of a ball being computer generated. The claimed phrase "a computer-generated three-dimensional representation of a ball" is being treated as a product by process limitation; that is, that the representation of the ball is formed using computer generation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. Furthermore, Kimbrough teaches creating a novelty article by disposing a three-dimensional face of a known person, which can include a famous athlete (column 3 lines 12-13), onto a computer generated model of a three-dimensional object (Figs. 1 & 3) in order to form a doll or other novelty article (Figs. 3 & 4). The three-dimensional face has a continuous facial surface extending beyond the surface to which it is applied (Fig. 3). The continuous facial surface extends beyond an objects surface at a continuous perimeter, which defines the boundary of the continuous facial surface relative to the objects surface (Fig. 3). The three-dimensional representation of the face is proportional to the represented face of the person (column 2 lines 15-20). The three-dimensional

representation of the face is created using a three-dimensional digital model of the face obtained by scanning the face of the person (abstract). It would have been obvious to one of ordinary skill in the art to have the novelty article of Cash and Burton formed using computer generation techniques in order to create a doll or novelty article having the realistic features of an actual person (abstract). The references do not expressly disclose the representation of the face being that of a famous athlete, however it is well known in the doll art to have the face of a doll resembling a famous person, athlete or celebrity, as such it would have been obvious to include this feature to increase the amusement value of the toy since it would be in a form that was well known and easily recognizable to a child. The references disclose the basic inventive concept substantially as claimed with the exception of a stand. Wolf discloses a stand configured to be a three-dimensional representation of a venue such as a stadium associated with a sport such as baseball (Fig. 1) that is used to hold sports memorabilia such as a ball (column 4 lines 9-19) which would allow for the three-dimensional representation of the ball and the three-dimensional representation of the face to fit on the stand (Fig. 3). The stand is configured to hold only one ball shaped piece of memorabilia (Fig. 3). It would have been obvious to one of ordinary skill in the art from the teaching of Wolf to display the sports novelty article on a stand associated with the sport venue of the novelty article in order to be able to easily display a sports collectible in an attractive and functional display since it is thematically related to the novelty article (abstract). The device of Cash, Burton, Kimbrough and Wolf discloses the basic inventive concept, substantially as claimed with the exception of the three-dimensional

representation of the ball and face being partially hollow. Lerner however, discloses a toy figurine where the head portion is hollow for storing the elements of the figurine within (Fig. 2). It would have been obvious to one of ordinary skill in the art from the teaching of Lerner to have the head portion be hollow in order to allow for elements to be stored within. The references disclose the basic inventive concept, substantially as claimed with the exception of the figurine arms and legs having joints shaped like sports balls. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to give the figurine ball shaped joints because Applicant has not disclosed that the ball shaped joints provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well without ball shaped joints because a simpler yet still fun and interesting toy with arms and legs is created. Furthermore, it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *See in re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In regard to the sizes of the components being related to the formula $V_B/2 \leq V_H - V_F \leq V_B$, the examiner notes that it has been held to be obvious for one to try and improve upon what is already known and as such to determine optimum ranges in which a device can work and function. *See In re Peterson*, 315 F.3d at 1330, 65 USPQ2d 1382. Furthermore, there appears to be no practical application for the device to be formed using this criteria.

7. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough, Wolf, Lerner and further in view of Official Notice. The references disclose the basic inventive concept, substantially as claimed, with the exception of using voice signal technology. Official notice is taken that it is well known in the doll art to use voice signal technology, as such it would have been obvious to include this feature to create a more interesting and interactive toy.

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough, Wolf and Lerner. The references disclose the basic inventive concept, with the exception of the face of the athlete being a caricature. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the face be a caricature because Applicant has not disclosed that a caricature provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the standard facial features because it would be more easily recognizable. Furthermore, it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *See in re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough, Wolf and Lerner. The references disclose the basic inventive concept, with the exception of the ball and face combination being fixedly secured to the stand. At the time the invention was made, it would have been an obvious matter of

design choice to a person of ordinary skill in the art to have the ball and face combination fixedly secured to the stand because Applicant has not disclosed that the novelty article being fixedly secured to the stand provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the ball and face combination being removable from the stand because it would allow the child to play with the ball once removed. Furthermore, it has been held that the use of an integral construction instead of a separable structure would be a matter of obvious engineering choice. *See in re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

10. Claims 38-43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Wong (6645101). Cash discloses a sports novelty article having a three-dimensional representation of a baseball with a face (48) positioned on the ball such that the ball continues from the face to form the remainder of the head (Fig. 1). The relative size of the representation of the ball and the representation of the face is such that the ball is generally the size of the representation of the head (Fig. 1). The three-dimensional representation of the ball is proportional to the represented ball (Fig. 1). The novelty article is a figurine with a body formed by arms and legs (14,16) that are disproportionate to the size of the face but proportionate to the head and wherein the combination of the three-dimensional representation of the ball and the face is selectively attachable to the figurine (Fig. 2). Burton discloses a ball shaped doll having three-dimensional facial features and a ball

that is generally the size of the represented head (Fig. 2) such that the representation of the face protrudes outwardly from the three-dimensional representation of the ball, showing this quality to be old in the ball figurine art. It would have been obvious to one of ordinary skill in the art to have the face of Cash display three-dimensional characteristics in order to have a doll with more interesting and visually appealing features. Cash and Burton disclose the basic inventive concept of a sports novelty article with the exception of the three-dimensional representation of a ball being computer generated. The claimed phrase "a computer-generated three-dimensional representation of a ball" is being treated as a product by process limitation; that is, that the representation of the ball is formed using computer generation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. Furthermore, Kimbrough teaches creating a novelty article by disposing a three-dimensional face of a known person, which can include a famous athlete associated with at least one sport (column 3 lines 12-13), onto a computer generated model of a three-dimensional object (Figs. 1 & 3) in order to form a doll or other novelty article (Figs. 3 & 4). The three-dimensional face has a continuous facial surface extending beyond the surface to which it is applied (Fig. 3). The continuous facial surface extends beyond an objects surface at a continuous perimeter, which defines the boundary of the continuous facial surface relative to the objects surface (Fig. 3). The three-dimensional representation of the face

is proportional to the represented face of the person (column 2 lines 15-20). The three-dimensional representation of the face is created using a three-dimensional digital model of the face obtained by scanning the face of the person (abstract). It would have been obvious to one of ordinary skill in the art to have the novelty article of Cash and Burton formed using computer generation techniques in order to create a doll or novelty article having the realistic features of an actual person (abstract). The references do not expressly disclose the representation of the face being that of a famous athlete, however it is well known in the doll art to have the face of a doll resembling a famous person, athlete or celebrity, as such it would have been obvious to include this feature to increase the amusement value of the toy since it would be in a form that was well known and easily recognizable to a child. The references disclose the basic inventive concept, substantially as claimed with the exception of making the article reversible for displaying an alternate face. Wong discloses an elastomeric hollow novelty article having a first three-dimensional representation of a face (Fig. 7) and a second three-dimensional representation of a face (Fig. 8) that is integral with a second portion of the article such that upon reversing the article the second face is revealed (column 1 lines 20-31). The novelty includes a plurality of protruding members that are configured to be able to fit within the hollow portion of the novelty and as such it would be able to accommodate the any body parts that would be attached thereto. It would have been obvious to one of ordinary skill in the art from the teaching of Wong to make the ball novelty of the above references reversible in order to allow for the display of different appearances of the toy giving it additional visual appeal.

11. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough, Wolf and Lerner. The references disclose the basic inventive concept, with the exception of V_B estimated by projecting the surface of the ball to generate an approximate volume and V_H estimated by projecting the surface of the face to generate an approximate volume. The claimed phrase "wherein the value for V_B is estimated by projecting the surface of the ball to generate an approximate volume, wherein the value for V_H is estimated by projecting the surface of the face to generate an approximate volume" is being treated as a product by process limitation; that is, that the volumes are determined by projecting. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference.

12. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Wong. The references disclose the basic inventive concept, with the exception of the second face of the athlete being a caricature. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the face be a caricature because Applicant has not disclosed that a caricature provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the standard facial features because it would be more easily recognizable. Furthermore, it has been held that

matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *See in re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).*

13. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Wong. The references disclose the basic inventive concept, substantially as claimed, with the exception of having the first face be associated with a first sport and the second face being associated with a second sport. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have faces associated with different sports because Applicant has not disclosed that a the different faces provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the standard facial features because it would be more easily recognizable. Furthermore, it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *See in re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).*

Response to Arguments

14. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

15. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Hylinski whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-5:30).

Art Unit: 3711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMH

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711